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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,415	11/29/2001	Morris Wiginton III	42338.830001.001	5955
26582	7590	11/29/2005		
HOLLAND & HART, LLP 555 17TH STREET, SUITE 3200 DENVER, CO 80201			EXAMINER INGBERG, TODD D	
			ART UNIT 2193	PAPER NUMBER

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,415

Applicant(s)

WIGINTON ET AL.

Examiner

Todd Ingberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Status

Claims 1 – 13 and 21 - 32 have been examined.

Claims 1, 4, 5, 7, 11, 21, 29, and 32 have been amended.

Claims 14 – 20 have been canceled.

Request For Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. “First User” critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant has redefined the role of “End User” to be more than one role.

The amended claims lack written description to be able to quantify the term “expert” user and “non expert” user. The two terms are not mutually exclusive. Because an individual

performs one role is not evidence that they are incapable of performing the other role. Claim 21 even has an “intermediate expert user”. It is not clear how many types of experts exist or the way to draw a distinction between them. The limitations are not given patentable weight. The terms only serve to indicate an intended use.

Furthermore, the term “*complex software packages*” has no support in the Specification to make a determination of what is complex and what is not complex. This limitation has no patentable weight. What is deemed complex to one of ordinary skill in the art may not be deemed complex by another of ordinary skill in the art.

These terms fail to provide a quantifiable distinction and are subject to opinion and speculation. These terms hold no patentable weight.

4. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “installing”, does not reasonably provide enablement for “implementing”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to software installation, the invention commensurate in scope with these claims. The Applicant has introduced the term “implement” or implementation while replacing the term install and installation. The Specification on page 6 has the word “**implementation**” but the word is not a term in the context to the invention only in a legal context.

5. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. The terms “**implementation**” and “**implement**” are not supported in the Specification. These terms are new matter.

6. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms “**derived**” is not supported in the original disclosure and is deemed new matter.

7. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms “**independent module**” is not supported in the original disclosure and is deemed new matter.

8. Claims 1 – 6 and 29 - 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations “wherein later addition of independent modules uses the solicited information from the non-expert user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the non-expert end user” are not supported in the original disclosure and is

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deemed new matter. How “*ensuring*” is performed as claimed with “ensure the later addition independent modules are implemented consistent with the software package” is new matter.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Profit as documented in “The Official Software Companion Microsoft Profit”, Microsoft Press by Stephen L. Nelson, published 1993. (referred to as **Profit1**).

Claim 1

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C), by an expert for use by a non-expert to solicit and implement business related data for a software package comprising at least one independent module (**Profit1**, Chapter 2, page 33, Select Business Type Figure 2-1), the method comprising the steps of:

generating at least one question definition screen (**Profit1**, pages 26, 33 and 228-229);
entering by the expert at least one question on the at least one generated question definition screen (**Profit1**, pages 26, 33, and 228-229 as per above the select business type), the at least one question entered by the expert being designed to solicit at least first information from an non-expert end user relating to a business of the non-expert end user (**Profit1**, pages 33 and 228-229, entry is a response to question);

determining whether additional information relating to the business of the non-expert end user is necessary to implement a the software package on a computer system of the non-expert end user (**Profit1**, page 35, select from Figure 2-2 determination made if Figure 2-3 is needed), the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information (**Profit1**, pages 26, 33, and 228-229 as per above the select business type);

if additional information is necessary, providing links to next questions to solicit additional information (**Profit1**, page 35, NEXT button on the bottom of screen);
if additional information is not necessary, compiling the at least one entered question into implementation installation software designed to solicit information from the non-expert end user relating to the business of the non-expert end user such that the solicited information from

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the non-expert user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one independent module of the software package can be implemented and installed on the computer system of the non-expert end (**Profit1**, page 26 and 35, Business set up to set up the components requested); and wherein later addition of independent modules uses the solicited information from the non-expert user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the non-expert end user (**Profit1**, page 26 and 35, Business set up to set up the components requested).

Claim 3

The method of claim 1, including the step of: saving the at least one question prior to a determination that additional information is not necessary. (**Profit1**, page 227, must determine where to install, Figure 8-2).

Claim 4

The method of claim 1, including the step of: providing links to help files (**Profit1**, pages 24 - 28, Help Contents), wherein such help files assist the non-expert end user in providing at least one response to the at least one question, the at least one response relating to the business of the non-expert end user (**Profit1**, page 26 and 35, Business set up to set up the components requested).

Claim 5

The method of claim 4, further comprising the step of providing at least one derived response for the at least one question, the at least one derived response corresponding to a generally accepted accounting principle. . (**Profit1**, page 66 – 68, General Ledger and Fiscal periods and year).

Claim 7

Profit1 anticipates an apparatus for enabling the development of **implementation** installation software wizards **for complex software packages comprising at least one independent module** (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1), comprising: at least one memory; at least one executable file stored in the at least one memory; the at least one executable file comprising at least one instruction for providing at least one question definition screen (**Profit1**, Chapter 2, page 33, Description of Company, Figure 2-1); a monitor; at least one processing unit to execute the at least one instruction to display the at least one question definition screen to at least one intermediate user (**Profit1**, page 33, Description of Company, Figure 2-1 – This is a Wizard); the at least one processing unit includes at least one input so the at least one intermediate user can input at least a first question (**Profit1**, page 33, Responding to the question on page 33), the first question to solicit information from an end user relating to a business of the end user (**Profit1**, page 33, Description of Company, Figure 2-1); such that the end user can input business information specific to the end user (**Profit1**, page 35, Figures 2-2 and 2-3); and a compiler to write all the received information (**Profit1**, page 76, In Conclusion, After the Questions of Chapter 2 are answered the information compiles the answers and generates an accounting package to meet the accounting needs described by the answers to the questions), wherein the received information is saved for the end user (**Profit1**, page 34, After

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the NEXT button is selected the information is saved the next part of the Wizard asks Company level information and page 75 end of questions mentions double checking your work and storing), wherein execution of the executable file solicits information from the end user to set options in and implement the **at least one independent module of the complex software package** (**Profit1**, page 33, Description of Company, Figure 2-1 and page 76, In Conclusion, After the Questions of Chapter 2 are answered the information compiles the answers and generates an accounting package to meet the accounting needs described by the answers to the questions).

Claim 9

The apparatus of claim 7, wherein the at least one memory comprises at least one help file. (**Profit1**, pages 22 – 23, reference book stored in the computer's memory).

Claim 10

The apparatus of claim 7, wherein the at least one processing unit includes a security module. (**Profit1**, page 36 – 38, Passwords and controlling access is a Security Module).

Claim 11

Profit1 anticipates a computer program product comprising: a computer usable medium having a computer readable code embodied therein for processing data to develop **implementation** installation software wizards **set up by an expert to assist a non-expert** end users in installing business related **complex** software packages (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1), comprising **at least one independent module** on a computer system of an end user (**Profit1**, page 33, Select Business Type Figure 2-1), the computer usable medium comprising: a question generation module configured to generate at least one question definition screen (**Profit1**, pages 26, 33 and 228-229, for the selected business type above); a receiving module configured to receive at least one question designed to solicit information from end user relating to a business of the end user (**Profit1**, pages 33 and 228-229, entry is a response to question and **Profit1**, Chapter 2, pages 32 – 36, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership);

a determining module configured to determine whether the business related **complex** software packages requires additional information to **implement** the business related **complex** software the computer system of the end user; a linking module configured to provide links to next questions if additional information is determined to be needed to **implement** the business related **complex** software (**Profit1**, page 35, NEXT button on the bottom of screen); for the end user question (**Profit1**, pages 26, 33, and 228-229 as per the select business type); a saving module configured to save the at least one received question (**Profit1**, page 76, finished answering the questions stores the information); and a compiling module configured to write the at least one received question (**Profit1**, page 32-36 as per above) saved by the saving module into the **implementation** software wizard for the end user. (**Profit1**, page 33, Description of Company, Figure 2-1 and page 76, In Conclusion, After the Questions of Chapter 2 are answered

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the information compiles the answers and generates an accounting package to meet the accounting needs described by the answers to the questions).

Claim 13

The computer program product of claim 11, comprising: a help module configured to provide help relating to the at least one question. (Profit1, pages 22 – 24, Help on specific topics and page 20, Help button on the selection in Figure 1-13).

Claim 21

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1) by an **expert** for use by a **non-expert** to solicit and implement business related data for a software package comprising at least one independent module (**Profit1**, page 33, Select Business Type Figure 2-1), the method comprising the steps of:

generating at least one question definition screen (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1);

entering by the **expert** at least one question on the at least one generated question definition screen (**Profit1**, pages 26, 33 and 228-229, for the selected business type above), the at least one question entered by the **expert** being designed to solicit at least first information from an **non-expert** end user relating to a business of the **non-expert end user** (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1);

determining whether additional information relating to the business of the **non-expert end user** is necessary to implement a the software package on a computer system of the **non-expert end user**, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information (**Profit1**, page 35, NEXT button on the bottom of screen) ,The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership – more than one question present in article);

if additional information is necessary, providing links to next questions to solicit additional information (**Profit1**, page 33, Select Business Type Figure 2-1 and **Profit1**, page 35, NEXT button on the bottom of screen), if additional information is not necessary, compiling the at least one entered question into **implementation** installation software designed to solicit information from **the non-expert end user relating to the business of the non-expert end user** (**Profit1**, pages 26, 33 and 228-229, for the selected business type above) **such that the solicited information from the non-expert user** is used to set specific options in the **at least one independent module of the software package** (**Profit1**, pages 26, 33, and 228-229 as per the select business type); requiring the solicited information so the **at least one independent module of the software package** can be **implemented** and installed on the computer system of the non-expert end (Profit1, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership); and

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wherein later addition of independent modules uses the solicited information from the **non-expert user** to ensure the later addition independent modules are implemented consistent with the software package **Profit1**, page 35, NEXT button on the bottom of screen); and at least the first information relating to the business of the **non-expert end user** (The intended use of a Installation Wizard as per - Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership).

Claim 22

The method of claim 21, further comprising the step of generating at least one help definition screen for each edit question screen. (Profit1, pages 25 – 28, Help by Topic for Setting Up and Customizing).

Claim 23

The method of claim 21, further comprising the step of providing a default business operating information answer for each generated edit question screen. (Profit1, page 48, Default settings – for purchases – Figure 2-11).

Claim 25

The method of claim 21 wherein the determining step includes comparing whether the inputted at least one question solicits all the plurality of business operating information necessary to install the business related software. (Profit1, pages 32 to 76 - Starting).

Claim 26

The method of claim 21, further comprising the step of saving the inputted at least one question and jump information prior to compiling the business software installation application. (Profit1, page 76, Final Starting decision).

Claim 27

A computer-readable medium having computer executable instructions for performing the acts of claim 1. (Profit1, pages 352 – 356, Profit is a computer executable program as evident by the document and the fact it is installed).

Claim 28

A computer-readable medium having computer executable instructions for performing the acts of claim 21 (Profit1, pages 352 – 356, Profit is a computer executable program as evident by the document and the fact it is installed).

Claim 29

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software, by an **expert** for use by a non-expert to solicit and implement business related data for a software package comprising at least one independent module , the method comprising the steps of:

generating at least one question definition screen ;

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entering by the **expert** at least one question on the at least one generated question definition screen, the at least one question entered by the **expert** being designed to solicit at least first information from an **non-expert** end user relating to a business of the **non-expert end user**;

determining whether additional information relating to the business of the **non-expert end user** is necessary to implement a the software package on a computer system of the **non-expert end user**, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information;

if additional information is necessary, providing links to next questions to solicit additional information; if additional information is not necessary, compiling the at least one entered question into **implementation** installation software designed to solicit information from the **non-expert end user** relating to the business of the **non-expert end user** such that the solicited information from the **non-expert user** is used to set specific options in the **at least one independent module** of the software package requiring the solicited information so the **at least one independent module** of the software package can be implemented and installed on the computer system of the non-expert end and

wherein later addition of independent modules uses the solicited information from the **non-expert user** to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the **non-expert end user** (Profit1, as per the rejections for independent claims 1 and 7 above).

Claim 32

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software, by an **expert for use by a non-expert** to solicit and implement business related data for a **software package** comprising **at least one independent module**, the method comprising the steps of:

generating at least one question definition screen; entering by the **expert** at least one question on the at least one generated question definition screen , the at least one question entered by the **expert** being designed to solicit at least first information from an **non-expert** end user relating to a business of the **non-expert end user** determining whether additional information relating to the business of the **non-expert end user** is necessary to implement a the software package on a computer system of the **non-expert end user**, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information;

if additional information is not necessary, compiling the at least one entered question into **implementation** installation software designed to solicit information from the **non-expert end user** relating to the business of the **non-expert end user** such that the solicited information from the **non-expert user** is used to set specific options in the **at least one independent module** of the software package requiring the solicited information so the **at least one independent module** of the **software package** can be **implemented** and installed on the computer system of the non-expert end; and

wherein later addition of **independent modules** uses the solicited information from the **non-expert** user to ensure the later addition independent modules are implemented consistent

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with the software package and at least the first information relating to the business of the non-expert end user (Profit1, as per the rejections for independent claims 1 and 7 above).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Profit as documented in "The Official Software Companion Microsoft Profit", Microsoft Press by Stephen L. Nelson, published 1993. (referred to as **Profit1**) as applied to claim 1 above, and further in view of basic use of Encryption as taught by Computer Security Basics from 1991 (Encryption) .

Claim 2

The method of claim 1, including encrypting the stored at least one entered question. Profit1 teaches the use of passwords (Profit, page 37, Figure 2-4 with controls). Passwords must be stored to enable validation (Profit1, page 37, Assigning passwords for users to access the system requires the storing them) . Encryption teaches encrypting passwords page 65. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the use of passwords of Profit1 with Encryption because access control makes systems secure.

Claim 12

The computer program product of claim 11, comprising: an encryption module configured to provided encryption. As per claim 2.

Claim 24

The method of claim 21, further comprising the step of encrypting the inputted at least one question and jump information. As per claim 2 and Profit1 completing password moving to another screen (Profit, page 37, Figure 2-4 with controls).

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13. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Profit as documented in "The Official Software Companion Microsoft Profit", Microsoft Press by Stephen L. Nelson, published 1993. (referred to as Profit1) as applied to claim 1 above, and further in view of "Setup Factory", User's Guide by Indigo Rose, 1998 (Factory)

Claim 6

The method of claim 4, including the step of: emailing a question to a help reference. (Profit1, page10, Support, phone support) (Factory, page 7, email support). Profit1 shows support via telephone but does not show support by EMAIL. It is Factory who teaches support by email. therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Profit1 and Factory, because email support provides for an easy means of providing hardcopy of help suggestions.

Claim 8

The apparatus of claim 7, wherein the at least one, memory, the at least one monitor, the at least one processing unit, the at least one input device, and compiler are coupled by at least one of a bus protocol, a wireless protocol, an intranet protocol, an extranet protocol, and html protocols. (Factory, page 7, EMAIL over the Internet uses an internet protocol).

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Profit as documented in "The Official Software Companion Microsoft Profit", Microsoft Press by Stephen L. Nelson, published 1993. (referred to as Profit1) as applied to claim 1 above, and further in view of USPN # 5,257,377 Sathi et al, October 26, 1993.

Claim 30

The computer program product of claim 29, further comprising a processor identification module configured to obtain computer system information about the system on which the business software package is being installed (Sathi, col 6, line 7 – 20, Processor ID). Profit1 teaches the installation of software (Profit1, Appendix C). What Profit1 does not teach is the recording of the processor ID the computer the software is installed on. Sathi teaches recording the processor ID. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Profit1 and Sathi because recording the ID of the machine software is installed on provides a means of preventing piracy.

Claim 31

The computer program product of claim 30, wherein the computer information system information includes information necessary to load the computer program. (Profit1, Appendix C, Installing Profit)

Response to Arguments

Rejection Under 35 U.S.C. § 112, first paragraph

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Applicant's Remarks

"In the July 28, 2005 Final Office Action the Examiner rejected claims 1-13 and 21-32 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The applicants respectfully traverse this rejection. In particular, the specification address a business software implementation installation program that assist an owner of the business software by requesting business specific information from the owner. The designations of first user verses second user were to clarify different owners, which clearly has sufficient support to convey to someone of ordinary skill in the art that the present inventors has possession of the claimed invention satisfying all requirements of 35 U.S.C. § 112 including the requirements associated with the written description. However, the applicants have redrafted the claims to eliminate the first user language so the present rejection of the claims under 35 U.S.C. § 112, first paragraph, is deemed moot. Withdrawal of the rejection under 35 U.S.C. § 112, first paragraph is respectfully requested."

Examiner's Response

Applicant's amendment is meet with a new grounds of rejection. In a similar way to the term "complex software packages". The attempt to distinguish between an "expert user" and a "non expert user" is not quantifiable. Furthermore, the two terms are no mutually exclusive. Would Applicant attempt to present that a user regardless of how they are termed by Applicant could not perform all roles in relationship to the invention. Applicant might be best served to focus on clearly and concisely claiming technical distinctions and avoid limitations that can not be given patentable weight because they fail to be quantifiable.

Rejection Under 35 U.S.C. § 103Applicant's Remarks

"In the Final Rejection, the Examiner maintained the rejection of claims 1, 3-11, 13-17, and 19-31 under 35 U.S.C. §103(a) as being unpatentable over the commercial product on a computer readable medium with memory and screen support "Setup Factory", User's Guide by Indigo Rose, 1998 (hereinafter referred to as "Factory") in view of "Profit: business management gets cute", PC Magazine, vol. 12, no. 8, pg. 54, April 27, 1993 (hereinafter referred to as "Profit"). Claims 2, 12, 18, and 24 have been rejected under U.S.C. §103(a) as being unpatentable over Factory and Profit as applied to claim 1, and further in view of basic use of Encryption as taught by Computer Security Basics from 1991 (hereinafter referred to as "Encryption"). Applicants respectfully traverse the rejections.

Amended claim 1 relates to and recites a combination of elements including, for example, a "method in a computer system for enabling the development of implementation installation software by an expert for use by a non-expert to solicit and implement business related data for a software package comprising at least one independent module," which is not disclosed, suggested, or taught by either Setup Factory, Profit, or Quicken. Setup Factory, for example, addresses a program to simply load a program onto a computer system. Setup Factory does not contemplate nor could it be modified to solicit implementation information to implement the loaded program because the loaded program is irrelevant to the fundamental purpose of Setup Factory. Rather, Setup Factory takes any program, independent of the information that program requires, and provides a tool to develop a wizard to assist the ultimate end user in loading that program on a computer system.

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Neither Profit nor Quicken cure the defect of Setup Factory. According to the Examiner, Profit solicits business information regarding the business type and ownership. However, Profit is silent regarding how the screen shown on page 33 of Profit is actually developed. Thus, Profit has no disclosure and is silent regarding the development of installation software to solicit business related information.”

Examiner's Response

Applicant should review Chapter 2 of the Profit reference. the Office does not find a defect as stated by the Applicant. In fact, the grounds of rejection is anticipation. on independent claims with the limitations Applicant is stating the Office has a defect. Why would one of ordinary skill in the art expect the reference to explain the underlying how a screen is displayed in product documentation in a for sale and for use commercial product. Applicant is reminded there are responsible for “being aware of all the pertinent prior art” (Customer Accessories Inc. v. Jeffrey-Allan Ind., Inc., 1 USPQ2d 1196 (Fed Cir. 1986). The references teach how to edit what is to be installed. This involves interacting with GUI screens which edits the installation script. Applicant points to page 33 of the Profit reference and places a burden on a single page and not the entire reference or the combination. Also, visibly absent is the recognition of the disclosure of the of “Profit: business management gets cute”, PC Magazine, v12, n8, p54, April 27, 1993 (Profit)reference where the reference explicitly mentioned the ability to build questions.

The following is from an independent claim:

“A method for generating a software implementation installation application to install complex business related software comprising at least one independent module plurality of interrelated independent modules where the business related software requires business operating information from an end user to be properly installed, the business related information being specific to a business of a specific end user and necessary to install the business related software package for the specific end user; the method comprising the steps performed on a computer of: identifying a plurality of business operating information necessary to implement and install the business related software; generating at least one edit question screen;”

No distinction in the claimed invention and the “intended use” of a Installation Wizard as taught by the prior art.

Applicant's new matter of the types of users is present. Applicant, if able to support such user roles. Should indicate how the roles differ from a Microsoft programmer (Expert) building the Profit product and bundling it for install with the features disclosed by the reference. How a user at a Customer site responsible for installing the product is not a potential separate user. And how the end user entering the set up questions is a potentially different user. And how a user entering Accounting information is not yet a potentially another user. None of these roles is mutually exclusive. Including the roles at the Customer site and even a Microsoft programmer volunteering at a charity and performing the roles described.

Applicant's Remarks

“Moreover, people of ordinary skill in the art understand that Great Plains Solomon Select/ Premier software, for example, needs to be tailored for particular industries to function

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properly. Thus, the questions to solicit information from, for example, a construction based company would be different than the questions to solicit information from, for example, a retail based company. Profit or Quicken, however, run the same program regardless of the actual type of company supplying the information. Thus, although Profit and Quicken may solicit information regarding what type of business and what type of ownership, the actual series of questions to solicit information is the same regardless of the answers. Thus, for at least this additional reasons, the present invention is distinguishable from both Profit and Quicken."

Examiner's Response

Early in the prosecution history the Patent Office requested a copy of documentation on commercial for sale and for use products mentioned in the Specification from Great Plains Solomon Select/ Premier software (see Office Action of February 24, 2005). The request failed to yield a disclosure. The references focus on the installation of financial software. The financial sector is a particular industry.

Applicant's Remarks

"Thus, even if Setup Factory and Profit or Quicken are properly combinable, they do not teach the present invention in any reasonable combination. At most, combining Setup Factory with Profit/Quicken would result in an installation LOAD program, where Profit would load into a particular path or directory of the computer system. Combining Setup Factory and Profit would not result in an installation IMPLEMENTATION program.

As explained previously, installation in general means both load and implement. The present claim I has been amended to more clearly define that the present invention relates to development of installation IMPLEMENTATION programs. Support for installation IMPLEMENTATION programs has been previously provided and is apparent throughout the specification, such as, for example, the original application at page 6, line 15, to page 7, line 3. This section similarly supports the expert and non-expert additions to the claims.

Claim 1 has also been amended to recite a "software package comprising at least one independent module" to further clarify the present invention, which also is not disclosed or suggested by the references. Setup Factory relates to installing a single program. Moreover, Profit and Quicken are single programs and not interrelated modules. The present invention, however, relates to complex software packages, such as the specifically referenced "Great Plains Solomon Select/ Premier" accounting software. As one of ordinary skill in the art would understand, complex software packages have numerous independent modules that can function together. Each module is a single program standalone program, but they can be interrelated. Moreover, additional modules can be added at subsequent times. Thus, unlike the references of record, information solicited allows "the plurality of independent modules of the software package [to be] implemented."

In other words, the references of record show development of a loading development program (factory) to place software on a system, but do not disclose or suggest an implementation development program to put the loaded program into effect. Thus, for the above referenced reasons, claim 1 is patentably distinct from the references of record either alone or in any reasonable combination thereof. Thus, withdrawal of the rejection of claim 1 and allowance of the claim is respectfully requested."

Examiner's Response

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The term “*complex software packages*” has no quantifiable value to the prosecution. There is no legal test or technical test to deem a software package as complex or not complex or determine any other degree of sophistication. The Specification provides no support for making this determination other than the appearance that the undisclosed product documentation of Great Plains Solomon Select/ Premier software somehow handles this unquantifiable standard.

It is the opinion of the Applicant what constitutes a complex software packages. This opinion does not serve as evidence. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Dependent Claims

Applicant's Remarks

“Amended claims 7, 11, 21, 29, and 32 contains limitations similar to amended claim 1 and at least by virtue of the similarity, is patentably distinct from the references of record either alone or in any reasonable combination thereof. Claims 2-6 and 8-10, 11-13, 22-28, 30, and 31 depend either directly or indirectly from claims 1, 7 11, 21, 29, and 32 and, at least by virtue of the dependency, are patentably distinct from the references of record either alone or in any reasonable combination thereof. Thus, withdrawal of the rejection of pending claims and allowance of the claims is respectfully requested.”

Examiner's Response

The arguments for the independent claims is not persuasive. Dependent claims remain rejected.

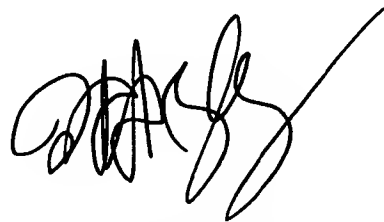
Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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A handwritten signature in black ink, appearing to read 'Todd Ingberg', with a long, sweeping horizontal line extending to the right.

Todd Ingberg
Primary Examiner
Art Unit 2193

TI